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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/682,657	10/09/2003	Jack Polonka	J6860(C)	8243

201 7590 10/07/2005

UNILEVER INTELLECTUAL PROPERTY GROUP
700 SYLVAN AVENUE,
BLDG C2 SOUTH
ENGLEWOOD CLIFFS, NJ 07632-3100

EXAMINER

LAMM, MARINA

ART UNIT PAPER NUMBER

1616

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/682,657	POLONKA, JACK	
	Examiner	Art Unit	
	Marina Lamm	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/9/03; 2/28/05</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Claims 1-20 are pending in this application filed 10/9/03.

Double Patenting

1. Applicant is advised that should claim 6 be found allowable, claim 20 will be objected to under 37 CFR 1.75 as being a substantial **duplicate** thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-12 and 15-20 are provisionally rejected under the judicially created doctrine of **obviousness-type double patenting** as being unpatentable over claims 1, 3-9 and 11-13 of copending Application No. 10/841,867 ('867). An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical,

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but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed invention overlaps with that previously claimed. Thus, Claims 1-12 and 15-20 of the instant invention are directed to a skin care composition comprising 0.01-10% by weight of solid single-crystal, flat, platy particles having an index of refraction of 1.8-2.2 and a cosmetically acceptable vehicle, wherein said compositions has an opacity of less than about 20%. Claims 3 and 4 of the instant invention recite bismuth oxychloride as the solid single-crystal, flat, platy particulate material; Claim 5 recites the size of the particles as being 10-30 microns. Claims 1, 3-9 and 11-13 of the copending application '867 recite a cosmetic composition comprising, among other ingredients, a light reflecting inorganic material of platelet shaped particles having an average particle size of 10-30 microns, and a cosmetically acceptable vehicle. Claim 3 recites bismuth oxychloride as the light reflecting inorganic material of platelet shaped particles; Claim 4 recites the reflective index of the light reflecting inorganic material of platelet shaped particles as being greater than about 1.8. Additionally, Claim 1 recites zinc oxide or zirconium oxide particles, which meet the limitation of "benefit agents" as recited in Claim 12 herein. The claims of copending application '867 do not recite the specific

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opacity of the composition of the instant claims. However, both inventions are directed to the compositions that provide natural skin appearance and skin radiance. Claims 1-12 and 15-20 cannot be considered patentably distinct over Claims 1, 3-9 and 11-13 of the copending application when there is a specifically disclosed embodiment in the copending application that supports the claims of that application and falls within the scope of Claim 1 herein because it would have been obvious to one having ordinary skill in the art to modify the composition of Claim 1 of the copending application by selecting a specifically disclosed embodiment that supports that claim, i.e., the compositions that provide natural skin appearance and skin radiance disclosed in the copending application. One having ordinary skill in the art would have been motivated to do this because that embodiment is disclosed as being a preferred embodiment.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-12 and 15-20 are provisionally rejected under the judicially created doctrine of **obviousness-type double patenting** as being unpatentable over claims 1-13 of copending Application No. 10/841,042 ('042). Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed invention overlaps with that previously claimed. Thus, Claims 1-12 and 15-20 of the instant invention are directed to a skin care composition comprising 0.01-10% by weight of solid single-crystal, flat, platy particles having an index of refraction of 1.8-2.2 and a cosmetically acceptable vehicle, wherein said compositions has an opacity of less

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than about 20%. Claims 3 and 4 of the instant invention recite bismuth oxychloride as the solid single-crystal, flat, platy particulate material; Claim 5 recites the size of the particles as being 10-30 microns. Claims 1-13 of the copending application '042 recite a cosmetic composition comprising, among other ingredients, light reflecting inorganic platelet shaped particles having an average particle size of 10-30 microns, and a cosmetically acceptable vehicle. Claim 5 recites bismuth oxychloride as the light reflecting platelet shaped particles. Additionally, Claim 1 recites zinc oxide or zirconium oxide particles, which meet the limitation of "benefit agents" as recited in Claim 12 herein. The claims of copending application '042 do not recite the specific opacity of the composition of the instant claims. However, both inventions are directed to the compositions that provide natural skin appearance and skin radiance. Claims 1-12 and 15-20 cannot be considered patentably distinct over Claims 1-13 of the copending application when there is a specifically disclosed embodiment in the copending application that supports the claims of that application and falls within the scope of Claim 1 herein because it would have been obvious to one having ordinary skill in the art to modify the composition of Claim 1 of the copending application by selecting a specifically disclosed embodiment that supports that claim, i.e., the compositions that provide natural skin appearance and skin radiance disclosed in the copending application. One having ordinary skill in the art would have been motivated to do this because that embodiment is disclosed as being a preferred embodiment.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-9, 11-13 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (US 2004/0120908).

Cohen et al. teach transparent concealing cosmetic compositions containing non-interference platelet particles having an average particle size of 25 microns or less. See Abstract. The platelet particles of Cohen et al. include bismuth oxychloride particles having an average particle size of 9-15 microns, for example those sold under the commercial name Biron B-50 by Rona. See [0012]; Table 1 @ p. 5; Example 5 @ pp. 6-7. Additionally, the platelet particles of Cohen et al. may include boron nitride and/or alumina. See [0010]; [0020]. The compositions of Cohen et al. may be used for any type of cosmetic products, e.g. for color cosmetic or for treatment products, the latter are being free from additional colorants. See [0018]; [0024]; Example 6 @ p. 7. The compositions may also contain skin benefit agents such as antioxidants, vitamins, sunscreens, skin-whitening agents, anti-aging agents, etc. See [0022]. The refractive index of the bismuth oxychloride particles is inherently within the claimed range of 1.8-

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2.2, because these are the same particles as used in the instant invention. The claimed Opacity of less than about 20% is inherent in Cohen et al., because the reference teaches transparent compositions. The Cohen et al. reference fails to teach the claimed concentration of the non-interference platelet particles. However, the determination of optimal or workable concentration of the non-interference platelet particles by routine experimentation is obvious absent showing of criticality of the claimed concentration. One having ordinary skill in the art would have been motivated to do this to obtain the desired concealment of skin flaws and/or "sparkling" effect of the composition.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (US 2004/0120908) in view of either Dreher (US 2003/0157041) or Miyazaki et al. (US 6,482,419).

Cohen et al. applied as above. The reference does not explicitly teach the particles suspended in a polar solvent prior to incorporation in the composition as claimed herein. However, Dreher teaches making optical make-up compositions for minimizing skin flaws by first suspending bismuth oxychloride and other inorganic particles in butylene glycol (polar solvent), then adding the mixture to the water (polar solvent) and pigments mixture; and then mixing the resulting water phase (with pigment particles suspended in it) with the oily phase. See Example 1 @ pp. 2-3. Similarly, Miyazaki et al. teach making their natural feel emulsion foundation by first dispersing inorganic particulate material in water and butylene glycol (polar solvents), and then mixing the resultant water phase with the oily phase of the emulsion. See

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Example 13 @ col. 10. Both, Dreher's and Miyazaki's compositions, when applied to the skin, give a high feeling of transparency, hide imperfections and give natural feeling and appearance of the skin. See Miyazaki et al. @ col. 10, lines 64-67; Dreher @ [0004]. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Cohen et al. such that to suspend their platelet particles in polar solvents such as water or glycols before incorporating the particle into the composition. One having ordinary skill in the art would have been motivated to do this to obtain imperfection-concealing compositions having natural skin feel and appearance as suggested by either Dreher or Miyazaki et al.

8. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (US 2004/0120908) in view of Tan et al. (US 6,511,672), supplied by the Applicant.

Cohen et al. applied as above. While teaching skin benefit agents, the reference does not explicitly teach the specific benefit agents of the instant claim. However, Tan et al. teach skin benefit agents such as vitamins (e.g. vitamin A or retinol, vitamins C and E), skin lightening agents, alpha- or beta-hydroxy acids, etc. in skin imperfection-concealing compositions. See col. 7, lines 32-64. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Cohen et al. such that to employ retinol or other skin benefit agents of Tan et al. for their art-recognized purpose. One having ordinary skill in

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the art would have a reasonable expectation of beneficial results such as an antioxidant effect.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 3,718,494; US 5,585,090; US 5,702,519; US 6,015,456; US 6,905,696; US 2002/0176833; JP 404128211 A (Abstract only).

10. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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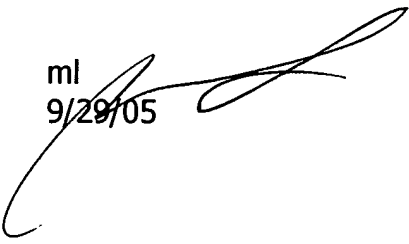
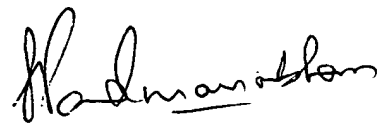
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have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

ml
9/29/05

A handwritten signature in black ink, appearing to be 'S. Padmanabhan', is written over the date '9/29/05'.A handwritten signature in black ink, appearing to be 'S. Padmanabhan', is written above the printed name and title.

**SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER**